

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed September 25, 2006. Claims 1-4, 7-13, 18-21, and 24-29 were rejected. Claims 1-4, 7-21, and 24-30 remain in the application. Claims 1-29 were originally presented. Claims 5, 6, 22 and 23 have been canceled without prejudice. Claims 14-17 were previously withdrawn, but are now allowable as depending from an allowable generic claim.

Claim Rejections - 35 U.S.C. § 103

As clarified by the Examiner by telephone on December 12, 2006, claims 1-4, 7, 9-13, 18-21 and 24-29 (including independent claims 1, 18, 25 and 29) were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ishii. Applicant respectfully traverses this rejection.

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. "The PTO has the burden under § 103 to establish a *prima facie* case of obviousness." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Additionally, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

With the above background in mind, the Applicant contends that the Office Action has failed to meet the burden of establishing a *prima facie* case of obviousness, and the obviousness-type rejections were based on hindsight.

Sato teaches a platen with a symmetrical hexagonal hole oriented with a point of the hexagon on a line parallel to the conveyance of the recording medium to prevent the corner of a sheet from entering into the hole, thereby preventing in poor sheet conveyance. (See FIGs. 2, 3, 5, and 6, and paragraphs 19-23 of the Sato reference.)

In contrast, Ishii teaches a plurality of rectangular or circular concave portions (see FIGs. 1a, 1b, 3-5, 7-8, 11- 12b, 14a, 14b, 16, 20-21, and paragraphs [0089], [0091], and [0108] of the Ishii reference) with a larger area than the area of a corresponding sucking hole. Moreover, Ishii teaches that this configuration maximizes sucking force so as to suck and absorb (concave) the recording medium into the recording medium delivery surface so as to reduce “cockling” of the recording medium. (See FIGs. 4 and 5, and paragraphs [0096], [0097], and [0111]). Ishii teaches that the sucking chamber is formed to increase the flow velocity of the flowing air so as to raise the negative pressure and take the recording medium into the sucking chamber. (See paragraph [0128] and [0129]).

Clearly, Sato teaches away from combination with Ishii because Sato teaches a configuration for preventing the recording medium from entering into the suction holes and Ishii teaches maximizing suction so as to absorb the recording medium into the holes. Thus, Sato and Ishii teach away from each other.

Furthermore, combining Sato with Ishii destroys the function of both Sato and Ishii. Sato teaches that the purpose of elongated hexagonal holes is to prevent the corner of a sheet from entering into a suction hole which results in poor sheet conveyance. In contrast, Ishii teaches the purpose of the rectangular or circular concave shape of the concave portion is to absorb or concave the recording medium so as to reduce floating or “cockling” of the recording medium between the concave portions. The symmetrical hexagonal opening of Sato, which is oriented with a point of the hexagon on a line parallel to the conveyance of the recording medium, provides the very opportunity for floating of the recording medium that Ishii was attempting to avoid since the suction force is reduced and the distance between the hexagonal openings is increased at the point of the hexagon. Additionally, the increased suction force and minimized distance between the suction chambers of Ishii draws the recording medium into the concave portions and, therefore, provides the very opportunity for a corner of a sheet to enter a hole and interfere with sheet conveyance, which Sato was attempting to avoid. Clearly, combination of Sato with Ishii would make both the corner saving function of Sato and the reduced floating function of Ishii inoperable. Thus, combining the two references would render each inoperable.

Moreover, it is unclear to Applicant how to combine the Sato and Ishii references or what structure would result. Specifically, it is unclear to Applicant how to combine the elongated

hexagonal hole of Sato, which is oriented with a point of the hexagon parallel to the conveyance of the recording medium, with the rectangular or circular concave portion of Ishii.

While Applicant cannot conceive of the geometry suggested by the combination of the Sato and Ishii references, clearly such a combination would not form a channel in the contact surface extending a length of the channel and having a varying cross-sectional area varying a depth of the channel along a portion of the channel, as claimed by the present invention. Because the teachings of Sato and Ishii oppose each other, the only way to combine the two references is to impermissibly pick and choose the desired elements without regard to the teachings of the references and based on the hindsight roadmap provided by the present application. Therefore, the Office Action has employed impermissible hindsight in rejecting the present application.

Accordingly, Applicant respectfully asserts that the contents of these references do not support the Office Action's proposed combination. Thus, the Office Action has not established a case of *prima facie* obviousness. Therefore, Applicant respectfully asserts that independent claims 1, 18, 15, and 29 are allowable and requests withdrawal of these rejections. The dependent claims are allowable for at least their dependence on an allowable independent claim.

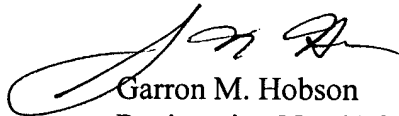
CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-4, 7-13, 18-21, and 24-30 are in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Robert D. Wasson at (360) 212-2338 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 19 day of Dec.

Respectfully submitted,



Garron M. Hobson
Registration No. 41,073

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone: (801) 566-6633